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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,685	02/09/2006	Keiji Sugiyama	20060094A	2117
513 7590 09/06/2007 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER JACOB, AJITH	
			ART UNIT 2169	PAPER NUMBER
			MAIL DATE 09/06/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/567,685

Applicant(s)

SUGIYAMA ET AL.

Examiner

Ajith Jacob

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/06
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The instant application having Application No. 10/567685 has a total of 8 claims pending in the application, there are 3 independent claims and 5 dependent claims, all of which are ready for examination by the examiner.

### ***Oath/Declaration***

2. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are directed towards software, *per se*. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d

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1031, 1035 (Fed. Cir. 1994). Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

4. Claim 1 is an apparatus claim that discusses a rule holding unit, but does not specify a physical piece of hardware to fulfill the claim, and thus has been rejected.

5. Claims 2-6 does not solve any of the non-statutory deficiencies of claim 1, and thus are rejected for the reasons stated above.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hattori et al. (US 2002/0065693 A1).

For claim 1, Hattori et al. teaches:

An information notification apparatus comprising:

a rule holding unit operable to hold (a) an information notification rule which is

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generated based on information concerning a preference of a specific user, the rule defining that predetermined information should be notified to the specific user in the case where the specific user satisfies a predetermined condition [user notified of condition of finding a store that carries the predetermined product to purchase, 0124-0130] and (b) an information notification rule which is generated based on information concerning a preference of another user [notification by wife to husband (second user to first), 0147]; and an information notification unit operable to notify the specific user of predetermined information which needs to be notified to the another user, in the case where a condition which is defined by the information notification rule concerning the another user is satisfied by the specific user [update of purchase memo on agent system and client terminal and second user purchase of item from specific users memo, 0146-0147].

For claim 2, Hattori et al. teaches:

The information notification apparatus according to Claim 1, wherein said rule holding unit is operable to hold at least one of the information notification rules in association with each of groups which is made up of users [user in a group, 0168], said information notification apparatus further comprises a group determination unit operable to manage information concerning each of the groups and operable to determine a group to which the specific user belongs [user determined to be in group, 0168], and said information notification unit is operable to notify the specific user of the predetermined information in the case where a condition which is defined by one of the information notification rules is satisfied by the specific user, the rule being held in

association with each of the determined groups [if user buys product, group is notified, 0168].

For claim 3, Hattori et al. teaches:

The information notification apparatus according to Claim 2, wherein said information notification unit is operable to notify the predetermined information to only members of groups to which each user belongs, the information being based on the information notification rule of each user [product purchase notified to users with product on list in group, 0172].

For claim 4, Hattori et al. teaches:

The information notification apparatus according to Claim 2, wherein the information concerning user's preference includes at least information indicating user's current position and preference [personal information and interest, 0114], said information notification apparatus further comprises a rule generation unit operable to generate the information notification rule based on inputted information which is necessary for generating an information notification rule based on information concerning user's preference [locating based on user preference, 0122-0125], the necessary information being received through one of a dialogic input from a user and a communication network [input from user and network communication, 0115], and said rule holding unit is operable to hold the respective information notification rules generated by the users, in association with one or more of the groups to which each user belongs [memo information of group of user, 0168].

For claim 5, Hattori et al. teaches:

The information notification apparatus according to Claim 2, wherein said information notification unit is operable to restrict the number of people to which information is notified to a predetermined number on a group-by-group basis, in the case where the number of users who satisfy a same condition at one time is plural [restriction of group to list by ID, 0184-0185].

For claim 6, Hattori et al. teaches:

The information notification apparatus according to Claim 1, said apparatus further comprising a behavior determination unit operable to determine whether the user who received the notification has behaved in a manner indicated in the notified information, based on one of the followings: an input received from a user; and data related to the notified information [user's past selection and reaction analyzed, 0180].

Claim 7 is a method of claim 1. Chen et al. teaches the limitations of claim 1 for the reasons stated above.

Claim 8 is a computer program of claim 1. Chen et al. teaches the limitations of claim 1 for the reasons stated above.

### ***Conclusion***

The Examiner requests, in response to this Office action, that support be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s). This will assist the Examiner in prosecuting the application.

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When responding to this Office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajith Jacob whose telephone number is 571-270-1763. The examiner can normally be reached on M-F 7:30-5:00 EST, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali can be reached on 571-272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9/1/2007

  
MOHAMMAD ALI  
PRIMARY EXAMINER

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